

REMARKS

This is a response to the Office Action mailed on July 24, 2007, in which claims 1-4, 9-13, 15-18, 26-30, 35, 36, 38-40, 42-49, 51, 57, 58, 64, 66, 67, and 69 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. (WO 2004/037960 A1) in view of Li et al. (U.S. Pat. No. 6,214,777 B1) and further in view of Zeman et al. (U.S. Pat. No. 6,458,343); claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. in view of Li et al., Zeman et al., and Behler et al. (U.S. Pat. No. 4,894,485); claims 19-24, 41, 56, 65, and 70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. in view of Li et al., Zeman et al., and Person Hei et al. (U.S. Pat. No. 5,723,418); and claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. in view of Li et al., Zeman et al., Person Hei et al., and Login et al. (U.S. Pat. No. 4,395,373).

Priority

In the Office Action, the Examiner stated that the prior-filed application, Application No. 10/294,851, fails to provide adequate support or enablement for claims 1, 30, 44, 57, and 67. Applicant notes this comment. However, the priority date of claims 1, 30, 44, 57, and 67 is not critical to the rejections in the Office Action. Therefore, a response is not necessary.

Rejections under 35 U.S.C. § 103(a)

In the Office Action, claims 1-4, 9-30, 35, 36, 38-49, 51, 56-58, 64-67, 69, and 70 were rejected under 35 U.S.C. § 103(a) in light of Abe et al. in various combinations with Li et al., Zeman et al., Behler et al., Person Hei et al., and Login et al. However, Abe et al. cannot be used alone or in combination with other patents to show obviousness because Abe et al. was first published May 6, 2004, which is after the filing date of the present application (February 18, 2004). Therefore, Abe et al. cannot be a prior art reference in the current application, and all of the rejections under 35 U.S.C. § 103(a) fail.

In the Office Action, independent claims 1, 30, 44, 57, and 67 were rejected under 35 U.S.C. § 103(a) as being unpatentable under Abe et al. in light of Li et al., and Zeman et al. As discussed above, Abe et al. is not a valid prior art reference. The two remaining references disclose a lubricant composition containing an alkoxylated alcohol (Li et al.) and teach that alkoxylated alcohols are commonly known antifoaming agents (Zeman et al.). Li et al. and Zeman et al. do not individually nor combined show, teach, or disclose a lubricant comprised of an ether carboxylate and a C₉ to C₁₁ propoxylated alcohol. Therefore, the rejections to claims 1, 30, 44, 57, and 67 should be withdrawn, and claims 1, 30, 44, 57, and 67 should be allowed.

In that independent claims 1, 30, 44, 57, and 67 are in condition for allowance, the rejections to claims 2-4, 9-29, 35, 36, 38-43, 45-49, 51, 56, 58, 64-66, 69, and 70, which depend therefrom should be withdrawn, and claims 2-4, 9-29, 35, 36, 38-43, 45-49, 51, 56, 58, 64-66, 69, and 70 should be allowed.

In the Office Action, claim 14 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. in light of Li et al., Zeman et al., and Behler et al. In that independent claim 1 is in condition for allowance, the rejection to claim 14, which depends therefrom, should be withdrawn, and claim 14 should be allowed.

In the Office Action, claims 19-25, 41, 56, 65, and 70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. in view of Li et al., Zeman et al., and Person Hei et al. In that independent claims 1, 24, 30, 44, 57, and 67 are in condition for allowance, the rejections to claims 19-25, 41, 56, 65, and 70, which depend therefrom, should be withdrawn, and claims 19-25, 41, 56, 65, and 70 should be allowed.

In the Office Action, claim 25 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Abe et al. in view of Li et al., Zeman et al., Person Hei et al., and Login et al. In that independent claim 1 is in condition for allowance, the rejection to claim 25, which depends therefrom, should be withdrawn, and claim 25 should be allowed.

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-4-

In conclusion, the application is in condition for allowance. Notice to that effect is requested.

Respectfully submitted,

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